

Remarks/Arguments

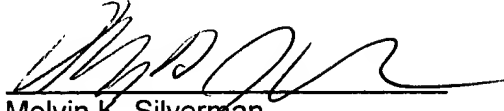
Reconsideration is hereby requested.

The sole basis of rejection of the claims of this application is United States Patent Application Publication No. US/2003/0220891 A1, published November 27, 2003, this based upon an effective filing date of December 22, 2000. Responsive to the §103(a) basis of rejection, under said publication to Fish, Applicant has submitted herewith a declaration under 37 CFR 1.131 to show prior invention relative to Fish. More particularly, the date of publication thereof is more than two years after the filing date of this Application. However, the effective filing date and, therefore, the presumptive date of invention of Fish is that of December 22, 2000, i.e., eight months prior to Applicant's filing date.

Earlier in the prosecution of this Application, an issue arose as to §120 subject matter continuity between the present application and that of its predecessor, namely, Application Serial No. 09/046,490, filed March 23, 1998. However, in light of Applicant's within Declaration under 37 CFR 1.131, a clear showing of prior invention relative to the December 22, 2000 date has been made. Thereby, the issue of "new matter" in the PTO practice sense of the phrase, has been obviated. The within declaration clearly shows not only invention prior to the year 2000 but, as well, that the invention of said 1998 application is one and the same as that of the present application, filed in 2001.

In view of the above, all objections and rejections of record have been satisfied and, as such, the early allowance of this application is indicated.

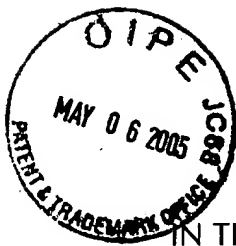
Respectfully submitted,
JAMES E. CROLEY

By: 
Melvin K. Silverman
Reg. No. 26,234

CUSTOMER NO. 27353

Enclosure:

Declaration under 37 CFR 1.131.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No. : 09/933,739
Applicant : James E. Croley
Filed : August 22/2001
TC/A.U. : 2173
Examiner : Ba Huynh

Docket No. : 1191.05
Customer No.: 27353

For : Method of Entering, Updating and Display of Related Data
on a Single Screen Page

DECLARATION UNDER 37 CFR 1.131

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, James E. Croley, do hereby declare and aver as follows:

1. I am the Applicant in the above-referenced Application for Patent.
2. My conception of this invention, as set for in the present Specification and Claims thereof, reverts to late 1997 and certainly prior to the filing of the parent of this application, that is, prior to March 23, 1998.
3. As a practicing ophthalmologist and ophthalmic surgeon, I became aware of the impracticality of multi-screen page forms and, thereby, undertook to develop a method of configuring data forms intended for real time use in a medical or technical context in which use of a multi-screen page form would be difficult or impractical.

4. At a point in time, at least as early as calendar 1999, I had reduced this invention to practice, was using such software in my practice, and had become associated with a company that had begun to market such software by calendar 2000.

5. The instant application arose as a consequence of the Final Rejection of December 21, 2000 (Ex. A herewith) of the above referenced parent application. More particularly, the rejection of all but one of the then pending claims of the parent application was an obviousness rejection based on Day (USPN 4,763,356) in view of Shelton (USPN 5,325,478). The abstracts thereof are Exs. B and C herewith. Apparently, the manner in which my invention was described in the 1998 patent application rendered it difficult for my counsel to explain to the former Examiner why the method reflected in my software invention differed from that of Day and Shelton as combined.

6. It thus became apparent to myself and counsel that the issue was one of communication, i.e., form, as opposed to substance. From this perspective, the present application was prepared and eventually filed on August 22, 2001, claiming the domestic priority of my 1998 application.

7. I understand from counsel that the sole extant basis of rejection of the pending claims of my present application is U.S. Patent Application Publication US2003/0220891A1 to Fish (Ex. D herewith) which bears a filing date and, thereby, a presumptive date of invention of December 22, 2000. Said date is one day subsequent to the above referenced Final Rejection (Ex. A) of December 21, 2000. Thereby, the instant invention, as reflected in my 2001

application, had long since been conceived and actually reduced-to-practice by December 22, 2000. Accordingly, to the extent that said reference to Fish (Ex. D) bears any relation to my method of entering, updating, and display of related data upon a single screen page, my invention was completed long prior thereto.

8. As well, the invention of my 2001 patent application, even if different from that of my 1998 application, was actually reduced to practice long prior to December 22, 2000.

9. Also, by reason of my vigorous prosecution of this application and its predecessor, and the nature of the reduction-to-practice of my invention in the 1997-99 period, I believe I have been diligent in both the factual and legal sense.

Declarant sayeth further naught.

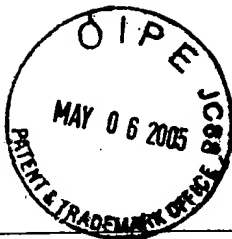
DATE

4/26/05


JAMES E. CROLEY

Enclosures:

- Ex. A: Office Action Summary (Final) 12/21/00.
- Ex. B: Patent No. 4,763,356 (Day), Aug. 9, 1998.
- Ex. C: Patent No. 5,325,478 (Shelton) Jun. 28, 1994.
- Ex. D: Pub. No. US2003/0220891 A1 (Fish).



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09:646,490 05/23/98 CROLEY

1191-01

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TN02/1221

EXAMINER

DELA TORRELO

ART UNIT

PAPER NUMBER

2173

DATE MAILED:

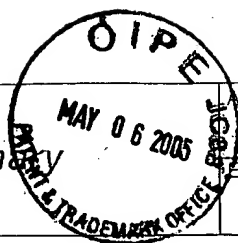
12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

BEST AVAILABLE COPY

Office Action Summary



Application No.
09/046,490

Applicant(s)

Croley III

Examiner

Crescelle Dela Torre

Group Art Unit

2173

☒ Responsive to communication(s) filed on Nov 13, 2000

☒ This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 5 and 8-10 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed

☒ Claim(s) 5 and 8-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2173

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 11/13/00.

This action is final.

2. Claims 5 and 8 - 10 are pending in this application. Claim 9 is the sole independent claim. In the Amendment, filed on 11/13/00, claims 5 and 8 were amended, claims 9 and 10 were added, and claims 1, 6, and 7 were canceled.

3. The present title of the invention is "Method of Entering and Updating Spatially Related Data" as filed originally.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 U.S.C. § 112

5. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not clear where in the specification applicant describes "key default fields" at line 3.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 5, "system" on line 1 should be --method--.

Claim Rejections - 35 U.S.C. § 103

8. Claims 5 and 8 - 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day, Jr. et al. (U.S. patent 4,763,356) in view of Shelton et al. (U.S. patent 5,325,478).

As per claim 9, Day, Jr. et al., hereinafter Day, teach a method of entering and displaying of spatially related data, comprising the steps of:

(a) configuring a data form, at Figs. 2 - 10, intended for real time use during an examination or technical inspection, into a geometry to display upon a display screen 21, at Fig. 1, and col. 2, line 30;

(b) providing a plurality of WINDOWS-based reference menus, including potential alpha-type entries for data fields defining the data form, with the menus at Figs. 3 - 7, 9;

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© providing, as an adjunct to certain data fields, a multiple choice menu of click-enterable alpha-type entries for the data fields, which are dynamically linked to plural WINDOWS-based reference menus, at Figs. 3, 4, 9, and col. 2, lines 58 - 68.

(d) selectably entering data from the reference menus into data fields of the form corresponding to the reference menus, at col. 3, lines 53 - 57;

(e) storing each completed historical data form, at col. 12, lines 38 - 48;

(f) designating certain fields as default fields, at col. 5, lines 26 - 41; and

(g) displaying the data entries of the default fields of each historical form of prior examination or inspections of a same person or subject, prior to entering step (d), at col. 5, lines 37 - 41, 48 - 58, and Figs. 8, 9.

Day teaches the above aspects of applicant's invention, but does not specifically teach that the entire data form is displayed upon a single screen. Rather, Day shows two pages, at Figs. 9, 10, for displaying the data.

On the other hand, it is known in the art that information can be displayed upon a single screen. For instance, Shelton et al., hereinafter Shelton, teach a method for information display which "consolidates information from various object instances onto a single form" at col. 2, lines 53 - 56, and as illustrated at Figs. 2, 10 - 12.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the information of Day in a single screen as in Shelton because it allows a user to view the entire form without having to navigate from one page to another.

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As to claim 5, Day teaches transposing data into a letter-type report format and printing the report, at col. 5, lines 26 - 36, which describes a "copy of a printed form", and also teaches providing the report to a third-party, at Fig. 14, and col. 12, line 64 to col. 13, line 5, which describes that each of the computers "may be arranged to bring up the same form".

As to claim 8, Day teaches: providing graphical annotations to a WINDOWS-based supplemental data field, which is dynamically linked to default fields, at col. 1, lines 43 - 45, col. 6, lines 12 - 14, and Fig. 10.

As per claim 10, Day teaches the following:

h) dynamically linking the default fields to plural WINDOWS-based reference menus corresponding to prior generations of examination or inspection of the same person or subject matter, at Figs. 3, 4, 9.

Response to Arguments

9. Applicant's arguments filed 11/13/00 have been fully considered but they are not persuasive.

Applicant's primary argument regarding the Shelton reference is that Shelton does not teach displaying the entire form upon a single screen display. The examiner does not agree because Shelton shows a single form entirely displayed on information screen 100, at Figs. 2, and 10 - 12, and col. 4, lines 64 - 65.

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Furthermore, regarding the Day reference, applicant points out that the default fields of Day are static, and not dynamic as in the present invention. Examiner agrees that certain data fields of Day are static, such as fields 85-2 and 85-3. However, Day also contains default fields which are dynamic, such as field 101, at Fig. 9, and col. 5, lines 59 - 66, that can be easily changed by an end-user of the system.

For these reasons, applicant's claims remain rejected.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Responses

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11. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Inquiries

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crescelle dela Torre whose telephone number is (703) 305-9782. The examiner can normally be reached on Mondays-Thursdays from 8:30 am to 4:00 pm, and on alternating Fridays from 8:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at (703) 308-3116.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

C. dela Torre
CRESCELLE N. DELA TORRE
PRIMARY EXAMINER
12/18/00